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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,575	08/05/2003	Trent West	81876-4095	5437

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WINSTON & STRAWN
PATENT DEPARTMENT
1400 L STREET, N.W.
WASHINGTON, DC 20005-3502

EXAMINER

MELWANI, DINESH

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,575

Applicant(s)

WEST, TRENT

Examiner

Dinesh N Melwani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08052003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 08/05/2003 is being considered by the examiner.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7, 10, 14, 16, 18, and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,062,045. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '045 patent to West discloses a jewelry article comprising an annular body made of a hard material.

Claim Objections

4. Claim 3 is objected to because of the following informalities: Inconsistency between claim language and specification. The disclose recites that the facets typically have an angle in the range of 1°-30°, however, claim 3 recites that the angle's range is 1°-40°. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oganessian (U.S. Patent No. 5,003,678) in view of Daniels *et al.* (U.S. Patent No. 3,776,706). Oganessian discloses a jewelry article (20) comprising an annular body made of a hard material, wherein the annular body has at least one curved external facet (A) that is ground to a predetermined shape with the hard material is long wearing and virtually indestructible during normal use of the jewelry article. Oganessian fails to disclose the use of tungsten carbide in fabricating the jewelry article's hard body. Daniels teaches the use of tungsten carbide in fabrication of jewelry articles such as rings, see col. 1, lines 30-46; col. 2, lines 45-50; and col. 4, line 49. Furthermore, the Applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). In regards to claim 2, Oganessian's jewelry article is in the form of a

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finger ring, wherein the annular body has an axis of symmetry and inner and outer circumferences and includes: a first frusto-conically shaped facet (A) extending around the outer circumference of said body, and forming a first outer facet of said body proximate a first axial extremity thereof; a second frusto-conically shaped facet (B) extending around the outer circumference of said body, and forming a second outer facet of said body proximate a second axial extremity thereof opposite said first axial extremity, and a cylindrically shaped exterior portion forming a third facet (24) extending around the outer circumference of said body and being disposed between said first and second facets. As it concerns claims 3, 6, 8, and 9, Oganessian discloses that said first and second facets have surface angles within the range of from 1 to 40 degrees relative to the axis of symmetry of the body and are ground and polished to a mirror finish. Regarding claim 4, the third facet is ground and polished to a mirror finish. In regards to claim 5, Oganessian further comprises a fourth frusto-conically shaped facet (C) extending around the inner circumference of the body, and forming a first inner facet of said body proximate the first axial extremity, and fifth frusto-conically shaped facet (i.e., the counterpart of facet (C)) extending around the inner circumference of the body, and forming a second inner facet of said body proximate the second axial extremity. Regarding claim 7, Oganessian, as modified by Daniels, discloses the use of sintered tungsten carbide containing at least 85 weight% tungsten carbide (i.e., 25 to 75 volume percent of carbide + 0 to 10 volume percent of a metal such as tungsten). As it concerns claim 10, 13, and 14, Oganessian's body includes a cavity (24) of a predetermined size and shape that is configured to receive an insert (58) of a decoration component that provides a substantially different visual effect of the article. Regarding claim 11, the cavity is a slot, groove, notch, or hole in a preselected location in the

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annular body. As it concerns claim 12, the cavity is a continuous groove or slot which extends entirely around the annular body. In regards to claims 19, 20, and 24, Oganessian, as modified by Daniels, discloses the use of a binding material, wherein said binding material comprises 3-10% percent Ni, see col. 7, line 51 and col. 2, lines 56-59. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teachings of Daniels, in regards to the use of tungsten carbide in the fabrication of jewelry articles, to modify Oganessian's invention to provide it greater resistance to wear.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hesse *et al.* (U.S. Patent No. 6,641,640), West (U.S. Patent No. 6,553,667), Warren *et al.* (U.S. Patent No. 6,260,383), and Canty (U.S. Patent No. 6,546,749) disclose the present invention substantially as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinesh N Melwani whose telephone number is 703-305-4546. The examiner can normally be reached on M-F, 8:30-6 except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


J. J. SWANN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DNM